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PATENT
Customer No. 22,852
Attorney Docket No. 02481.1737-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Olaf RITZELER et al.) Group Art Unit: 1625
Application No.: 10/627,978) Examiner: Z. Davis
Filed: July 28, 2003)
For: SUBSTITUTED BETA CARBOLINES) Confirmation No.: 4099

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

This communication responds to the Office Action dated September 7, 2004.

Claims 35-69 are pending in this application. The Examiner required restriction under 35 U.S.C. § 121 to one of the following six groups of inventions:

Group I: Claims 35-51 drawn to a compound, composition, process according to formula 1.

Group II: Claims 52-65 drawn to a method using a compound of formula I.

Group III: Claim 66 drawn to another method of using a compound of formula I.

Group IV: Claim 67 drawn to a method for preparing a pharmaceutical consisting of a compound according to formula I.

Group V: Claim 68 drawn to a method for preparing a pharmaceutical consisting of a compound according to formula II.

Group VI: Claim 69 drawn to another method of preparing a pharmaceutical using a compound of formula II.

Applicants bring to the Examiner's attention that the claims designated in Group I are drawn to compounds of formula I (35-37), compounds of formula II (38-41), a process for preparing a compound of formula I (42-50) and a pharmaceutical composition comprising a

compound of formula I (51). Claim 66 in Group III recites a method of using a compound of formula II. By reciting "compound of formula I" or "compound of formula II" in this response, applicants also intend to include the physically tolerable salts of the compounds mentioned in the claims.

Applicants provisionally elect, with traverse, the claims of Group I (claims 35-51). Applicants traverse this restriction requirement because there would be no serious burden on the Examiner to examine all Groups together. In paragraphs 3-4 of the Office Action, the Examiner explains why it is believed that the inventions are distinct. Even if the inventions were distinct, the Office Action does not provide an explanation, as required by MPEP § 803, of why examination of those inventions together would create a serious burden.

Apart from the propriety of the restriction requirement, at least claims 52-66 (Groups II and III) should be rejoined for examination once the claims of Group I are found allowable. MPEP § 821.04 states that "if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined." The method claims of Groups II and III depend either directly or indirectly from claims 35 or 38 in Group I and should therefore be rejoined for examination when claims 35 and 38 are found allowable.

The Examiner also required applicants under 35 U.S.C. § 121 to elect a species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Applicants traverse this requirement because there should be no serious burden to examine the full scope of the elected claims in their entirety. For purposes of being responsive to the election requirement, applicants elect a compound of formula I with the following features:

- B₆ to B₉ are carbon atoms;
- R⁴ is -NH-C(O)-R¹⁵, where R¹⁵ is pyridyl;
- R³ is -O-R¹⁰, where R¹⁰ is methyl;
- R² is chlorine;
- R¹, R⁵, R⁶, R⁷ and R⁸ are each hydrogen.

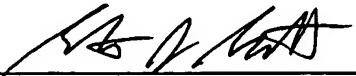
Claims 35-37, 39, 42-65 and 67-69 read on this elected species.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: September 24, 2004

By: 
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